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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,713	10/29/2001	Johannes J. Mons	PHN 16-657A	5400

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P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,713	Applicant(s) MONS, JOHANNES J.	
	Examiner TAN X. DINH	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/15/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 62 is/are allowed.
- 6) ☒ Claim(s) 31, 40, 41, 50, 51, 56, 58, 63, 64, 79, 80 and 94 is/are rejected.
- 7) ☒ Claim(s) 32-39, 42-49, 52-55, 57, 59-61, 65-78, 81-93 and 95 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1) The amendment filed 7/15/2004 is acknowledged.

2) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3) Claims 31,40,41,50,51,56,58,63,64,79,80 and 94 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,16 and 23 of U.S. Patent No. 6,353,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

Art Unit: 2653

The rejections in previously Office action is repeated herein.

4) Claims 32-39,42-49,52-55,57,59-61,65-78,81-93 and 95 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5) Claim 62 is allowable over prior arts of recorded.

6) Applicant's arguments filed 7/15/2004 have been fully considered but they are not persuasive.

a) Applicant state that " the parent case of the present invention (U.S. Patent No. 6,353,580) can be used as a basis for a double patenting rejection, but cannot be treated as prior art ". As indicated in previously Office action, this nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. The examiner did not treat the U.S. Patent No. 6,353,580 as prior art. The Examiner just comparing and pointing out the different between the claims in this instant application and the U.S. Patent No. 6,353,580 and provides an

Art Unit: 2653

analysis of the obviousness. For example, the different between claim 16 of U.S. Patent No. 6,353,580 and claims 31,51 and 63 of this instant application is " the audio information can be accessed using either TOC access mechanism or file-based access mechanism ". However, this feature is inherent in claim 16 of U.S. Patent No. 6,353,580 as seen in lines 5-12 which teaches that the table-of-content (TOC) access mechanism can be used for storing and accessing audio information, and file-based access mechanism can be used for storing and accessing audio information. In another words, these phrases have the same meaning as claimed in claims 31,51 and 63 which is " the audio information can be accessed using either TOC access mechanism or file-based access mechanism ". This is not prior art rejection as applicant argued, this is merely a rejected under the judicially created doctrine of obviousness-type double patenting with obviousness analysis.

b) Applicant state that " the Examiner has cited no prior art, whatsoever, showing that the differences between the rejected claims of the present invention and the claims to U.S. Patent No. 6,353,580 amount to an obvious modification of Claims 1,16 and 23 of U.S. Patent No. 6,353,580. Without a prior art recitation to substantiate an obvious-type double patenting rejection, there is no factual basis upon which the assertion of obviousness can be measured. Therefore, the double patenting rejection cannot stand."

Art Unit: 2653

However, the nonstatutory double patenting rejection does not require another prior art as long as it provides the rationale of obviousness.

The question is that any claims in this application define an invention that is merely an obvious variation of an invention claimed in the patent ?. The answer is yes in this case, claims 31,40,41,50,51,56,58,63,64,79,80 and 94 in this instant application defined an invention that is merely an obvious variation of claims 1,16 and 23 of U.S. Patent No. 6,353,580 (Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000)).

For those reasons, the rejection of the claims as indicated above are still proper and made final.

The same arguments are applied for the rejections of 40,41,50,56,64,77,79,80 and 94.

7) THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2653

A shortened statutory period for reply to this final action is set to expire *THREE MONTHS* from the mailing date of this action. In the event a first reply is filed within *TWO MONTHS* of the mailing date of this final action and the advisory action is not mailed until after the end of the *THREE-MONTH* shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than *SIX MONTHS* from the mailing date of this final action.

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Art Unit: 2653

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

October 12, 2004